

REMARKS

I. Introduction

Claims 1 to 8 are currently pending in this application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Priority Date Which Application is Entitled To

The Examiner asserts that the effective filing date for claims 1 to 8 is April 7, 1992, the filing date of continuation-in-part application serial no. 07/864,680 ("680"). The Examiner asserts that the '680 application is the first application of Applicants' prior applications which discloses a printing plate having opposite ends and being wrapped about a plate cylinder. Applicants respectfully disagree and submit that claims 1 to 8 are entitled to the filing date of ancestor application serial no. 07/417,587 ("587"), filed on October 5, 1989, for the reasons set forth below.

To be entitled to the benefit of priority from an earlier-filed patent application 35 U.S.C. §120 generally requires the following:

1. The continuing and earlier applications must both be pending simultaneously at one point in time (i.e., the *copendency* requirement);
2. The earlier application must have at least one inventor in common with the continuing application;
3. The continuing application must contain a reference to the earlier application; and
4. The continuing application must be for the same invention that was adequately disclosed in the earlier application.

Applicants submit that the present application and the '587 application meet the copendency requirement and have at least one inventor in common. Applicants further submit that the present application contains a reference to the '587 application.

Applicants further submit that the present application is for the same invention that was adequately disclosed in the ancestor '587 application. Figure 1 of the '587 application shows plate cylinders 22 and 24. The surface of the printing plate mounted on cylinder 22 is indicated by reference numeral 42. Further, the

specification at p. 6, lines 25 to 26, states that "[u]pper and lower plate cylinders 22 and 24 support printing plates". It is submitted that the disclosure in the ancestor '587 application of a printing plate mounted on a plate cylinder would reasonably convey to a person of ordinary skill in the art in 1989 a printing plate having opposite ends and wrapped around a plate cylinder, as recited in claim 1.

"If matter added through amendment to a C-I-P application is deemed inherent in whatever the original parent application discloses. . .that matter. . .is entitled to the filing date of the original, parent application. " *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1438, 221 USPQ 97, 106 (Fed. Cir. 1984). Further, the later explicit description of an inherent property does not deprive the product of the benefit of the filing date of the earlier application. *Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d at 422-23, 5 U.S.P.Q.2D (BNA) at 1197-98, cert. denied, 486 U.S. 1008, 100 L. Ed. 2d 198, 108 S. Ct. 1735 (1988).

Applicants herein submit and refer the Examiner to the Declaration of Harvey Levenson, Ph.D., an expert in the printing art. It is Dr. Levenson's opinion that the recitation of a printing plate mounted on a plate cylinder in Applicants' earlier filed '587 application conveys to a person of ordinary skill in the art in 1989 a printing plate having opposite ends and wrapped around a plate cylinder. See Levenson Declaration. As Dr. Levenson notes, according to a 1989-dated printing manual, the printing couple on a blanket-to-blanket web offset lithographic press includes "[a] plate cylinder, on which the plate is mounted. The plate is thin metal sheet that wraps around the cylinder surface and carries the image." David B. Crouse & Robert J. Schneider, Jr., *Web Offset Press Operating* 15 (3d ed. 1989) (Exhibit B to Levenson Declaration). Accordingly, Applicants submit that opposite ends, as recited in claim 1, is an inherent property of printing plates. Applicants further submit that being wrapped around a printing cylinder is an inherent property of a printing plate mounted on a printing cylinder. Therefore, Applicants' more explicit description of the printing plate in the '680 application does not deprive Applicants of the earlier filing date of the '587 application. See *Kennecott Corp.*, *supra*.

Further, a claim in a CIP application is entitled to the filing date of the parent application when the claimed invention is described in the parent specification in a manner that satisfies, inter alia, the description requirement of 35 U.S.C. § 112. *Therma-Tru Corp. v. Peachtree Doors Inc.*, 33 USPQ 2d at 1276 (Fed. Cir. 1995).

The first paragraph of 35 U.S.C. § 112 merely requires that the specification reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner admits to the "conventionality of a . . . printing plate (28 or 30) wrapped around a plate cylinder (24 or 26) and the plate having opposite ends inserted into a gap (44 or 46) of the plate cylinder". See Office Action at p. 3 (emphasis added). Given the conventional nature of the printing plate Applicants submit that the printing plate mounted on a plate cylinder, as described in the '587 specification, reasonably conveys to one skilled in the relevant art that the inventors in 1989 had possession of the claimed invention, including a printing plate having opposite ends wrapped around a printing cylinder, as recited in claim 1.

U.S. Patent No. 4,953,461 ("Gaffney et al. '461"), currently cited against pending claims 1 to 8, which issued from an application originally filed in the United States in 1988, further reinforces Applicants' argument that a printing plate mounted on a plate cylinder, as described in the '587 specification, reasonably conveys to one skilled in the relevant art that the inventors in 1989 had possession of the claimed invention, including a printing plate having opposite ends wrapped around a printing cylinder, as recited in claim 1. In describing the printing plate and its connection to the printing cylinder Gaffney et al. '461` state the following:

"A pair of plate cylinders 24 and 26 carry printing plates 28 and 30 having cylindrical peripheral surfaces which engage the surfaces 16 and 18 of the blanket cylinders 12 and 14." See col. 2, lines 45 to 48 and Figure 1.

Further, when describing the problem relating to gaps created by the printing plates Gaffney et al. '461 mention that opposite ends of the printing plates repeatedly impact the blanket cylinders. See col. 3, lines 6 to 15. Thus, Applicants submit that those skilled in the art in 1989 appreciated the term "plate" to mean a flat metal sheet having opposite ends that wraps around and is secured to a print cylinder. Further, the Examiner's reliance on Gaffney et al. '461 in the 35 U.S.C. §103(a) rejection of claims 1 to 8 to establish the "conventionality of a blanket on a blanket cylinder (12 or 14) having a continuous surface (16 or 18) and a printing plate (28 or 30) wrapped around a plate cylinder (24 or 26) and the plate having opposite ends inserted into a gap (44 or 46) of the plate cylinder", see Office Action at p. 3 (emphasis added), is inconsistent with the

Examiner's current position. The Examiner is, in effect, acknowledging that one of ordinary skill in the art in 1989 would have appreciated the recitation of a printing plate mounted on a plate cylinder in Applicant's earlier filed '587 application to convey a printing plate having opposite ends and wrapped around a plate cylinder, as recited in claim 1, and that a printing plate mounted on a plate cylinder, as described in the '587 application, reasonably conveys to one skilled in the relevant art that the inventors in 1989 had possession of the claimed invention, including a printing plate having opposite ends wrapped around a printing cylinder, as recited in claim 1. Accordingly, Applicants respectfully submit that claims 1 to 8 of the present application are entitled to an effective priority date of October 5, 1989, the filing date of the '587 application.

III. Rejection of Claims 1 to 8 Under 35 U.S.C. § 103 (a)

Claims 1 to 8 were rejected under 35 U.S.C. §103(a) as being obvious over CA 2,026,954 ("Gaffney et al. '954") in view of Gaffney et al. '461. Claims 1 to 8 were also rejected under 35 U.S.C. §103(a) as being obvious over Gaffney et al. '461 in view of Gaffney et al. '954.

For the reasons set forth above, Applicants respectfully submit that Gaffney et al. '954 does not constitute prior art against claims 1 to 8. As indicated above, claims 1 to 8 of the present application are entitled to an effective priority date of October 5, 1989, the priority date of application serial no. 07/417,587, which is before the April 10, 1990 filing date of Gaffney et al. '954. Therefore, withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 1 to 8 is respectfully requested.

IV. Nonstatutory Double Patenting Rejection of Claims 1 to 5

Claims 1 to 5 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,386,100 in view of Gaffney et al. '461. The Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. Applicants herein enclose a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the nonstatutory double patenting rejections of

claims 1 to 5. Therefore, withdrawal of the nonstatutory double patenting rejection and allowance of claims 1 to 5 is respectfully requested.

V. Nonstatutory Double Patenting Rejection of Claims 1 to 8

Claims 1 to 8 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of U.S. Patent No. 5,440,981 in view of Gaffney et al. '461 and Gaffney et al. '954. The Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. Applicants herein enclose a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the nonstatutory double patenting rejections of claims 1 to 8. Therefore, withdrawal of the nonstatutory double patenting rejection and allowance of claims 1 to 8 is respectfully requested.

VI. Nonstatutory Double Patenting Rejection of Claims 1 to 8

Claims 1 to 8 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 5 of U.S. Patent No. 5,429,048 in view of Gaffney et al. '954. The Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome this rejection. Applicants herein enclose a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the nonstatutory double patenting rejections of claims 1 to 8. Therefore, withdrawal of the nonstatutory double patenting rejection and allowance of claims 1 to 8 is respectfully requested.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

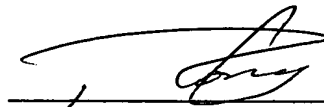
Attached hereto is a marked-up version of the changes made to the Specification by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

Respectfully submitted,

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By: _____



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

On page 9, the paragraph starting on line 23 has been amended as follows:

--Furthermore, the printing blanket 18 has a cylindrical outer surface 40 which is continuous and free of gaps to promote smooth rolling engagement with the cylindrical outer surface of the printing plate 41 on the plate cylinder [18] 22. The absence of gaps in the smooth cylindrical outer surface 40 of the printing blanket 18 eliminates bumps or vibrations as compared to having a gap which rolls into and out of engagement with the surface of the printing plate 41 on the plate cylinder 22. The elimination of bumps or vibrations tends to minimize smearing of the ink pattern as it is applied to the surface 40 of the printing blanket 18 by the printing plate 41 on the plate cylinder 22.--.